



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter Collinge
Serial No.: 10/032,692
Title of Invention: APPLE VARIETY NAMED 'CJ07'
Filing Date: December 27, 2001
Examiner: S. McCormick-Ewoldt, Art Unit 1661
Docket N^o: HR1.P04

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 7, 2004
Yakima, Washington 98902

10/13/2004 HALI11 00000002 10032692

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APPEAL BRIEF

Sir:

This Appeal Brief is submitted pursuant to the Notice of Appeal filed August 25, 2003 in the above referenced application. Because this brief is submitted later than the prescribed two month period for submitting an Appeal Brief after the Notice of Appeal is filed, a Petition to Revive an Unintentionally Abandoned Application for Patent is submitted concurrently herewith. The Appeal Brief fee of \$340.00, as required under 37 CFR 1.192(a), is enclosed. Any over or underpayment of the required fee may be charged to PTO deposit account no. 50-0269.

The following paragraphs are identified by paragraph numbers, which correspond with the requirements for an Appeal Brief set forth in 37 CFR 41.37.

1. Real Party in Interest: The Horticulture and Food Research Institute of New Zealand Ltd., assignee of record of the entire right, title and interest in the patent application, is the real party in interest in this appeal.

2. Related Appeals and Interferences: Pending U.S. plant patent application nos. 09/449,135, 09/590,861, and 09/905,574 have been appealed to the Board of Patent Appeals and Interferences for consideration of the same issue that is raised in this appeal. Application No. 09/905,574 is owned by the owner of the currently appealed application. Other than these related applications, there are no pending appeals or interferences known to the appellant, the appellant's legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

3. Status of Claims: This appeal relates to a plant patent application under 35 USC 161 *et seq.*, and as such includes a single formal claim directed to the plant shown and described in the specification. The claim stands rejected under 35 USC 112. Applicant hereby appeals the rejection of the single claim in the application.

4. Status of Amendments: All amendments submitted by the Applicant have been entered.

5. Summary of Claimed Subject Matter: The invention is a new and distinct apple tree named 'CJ07.' 'CJ07' originated as a whole tree mutation of its parent 'Sciearly' (USPP 11,092), distinguishable from its parent by early development of bright red fruit color.

6. Grounds of rejection to be reviewed on appeal: The application stands rejected under 35 USC 112, first and second paragraphs. The issue on appeal is whether the specification meets the written description requirements of 35 USC 112, first and second paragraphs, and 35 USC 162.

7. Argument:

The application has been rejected under 35 USC 112, first and second paragraphs. The Examiner in this application contends that the specification does not meet the requirements set forth in 35 USC 112, first and second paragraphs, because the Applicant has not supplied botanical detail regarding the new plant in sufficient detail to meet the requirements of the statute. Specifically, the Examiner asserts that the description of the variety is incomplete because the Applicant has provided allegedly inadequate descriptions of certain botanical features of the claimed plant. The Applicant contends that the specification is reasonably complete, and that the rejection under 35 USC 112 is improper. Applicant's position is well supported by statutory and judicial law, as set forth in the following paragraphs.

History of the Written Description Requirement for Plant Patents (35 USC 112, 162)

Congress passed the Plant Patent Act (now 35 USC 161 et seq.) in 1930 to give to plant breeders the same rights afforded to those in industry who invent and improve technology. At the time the Act was passed, Congress recognized that plant patent applications could not contain an

enabling description of the plant to be patented, so the Act was written to include a special exception with respect to the written description requirements of 35 USC 112, first and second paragraphs. In what is now 35 USC 162, Congress modified the application of 35 USC 112 to plant patents:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. . . .

At no time since the inception of the Plant Patent Act of 1930 has an Applicant for a plant patent been required to provide an enabling description of the variety for which plant patent protection is being sought. The applicable standard for the written description of the new plant variety claimed in the present application is the "complete as reasonably possible" standard set forth in 35 USC 162. The standard is further borne out in 37 CFR 1.163(a):

The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents...

In the present application, the Applicant has provided a skillfully written botanical description of the new plant to be patented, including a description of the characteristics that distinguish the new plant. At no point in the prosecution has the Examiner indicated that the specification fails to distinguish the new plant over its parent or other known varieties, nor has the application been rejected under 35 USC 102.

Scope of the Plant Patent Claim

The scope of the claim in a plant patent application is established by statute. 35 USC 163 reads:

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using,

offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

Unlike utility patent claims, the scope of the claim in a plant patent is unaffected by the scope of the written description or the language of the claim itself. The botanical description and illustrations included in a plant patent application assist in identifying the plant claimed, but have no impact on the scope of the claim. The scope of the claim in a plant patent includes the specific plant described and pictured in the specification, as well as any plants asexually reproduced from that plant. No other plant can fall within the scope of the plant patent claim, regardless of apparent similarity or even identity with the claimed plant. (See *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, discussed below). In recognition of the immutability of the scope of a plant patent claim, 35 USC 162 provides that “The claim in the specification shall be in formal terms to the plant shown and described.”

Applicant Has Met the Requirement that the Description be Reasonably Complete

35 USC 162 acknowledges that an enabling written description cannot be provided for a plant, and allows instead a reasonably complete description. Applicant asserts that for the purposes of a plant patent specification, a reasonably complete description identifies the novel, distinguishing, and non-variable characteristics of a new plant variety, and additionally points out commercially relevant features of the variety. A reasonably complete description does not include each and every quantifiable feature of the plant. While a highly detailed description may have merit for some purposes (such as breeding program records, botanical publications, researcher's notes, etc.), it is neither required by law nor appropriate in a plant patent application.

A highly detailed and exacting patent specification may be appealing to a botanist, a patent Examiner, or a patent Applicant, but it is not more useful in defining the scope of the enforceable rights of the patent owner than a reasonably complete specification that points out the distinguishing characteristics of the variety.

A quantitative recitation of variable characteristics fails as a “reasonably complete” description as required by the statute. Without taking into consideration the unique attributes of plants as patentable subject matter, one might conclude that if some description is good, i.e., reasonably complete, then more description must be better. In a utility patent application, this may be true. In a plant patent, however, no such description is required, or useful. The botanical description in a plant patent application is intended to aid in identifying the claimed plant, not to enable the reader to make the invention. A botanical description which exceeds the “reasonably complete” standard by providing a description of variable characteristics does not aid in identifying the plant, but in fact introduces vague and ambiguous information. Rather than serving to improve the quality of the disclosure in a plant patent application, the addition of unnecessary, vague or ambiguous information diminishes its value as an aid in identifying the claimed plant. A reasonably complete description of a plant is limited to characteristics which are not subject to a great deal of variability, and which are used by those skilled in the art to identify plants of the variety claimed.

Many of the characteristics for which the Examiner has requested additional descriptive information are subject to substantial variability. Some of the variables which can affect the observable characteristics of fruit trees include: soil type; fertilizers and agricultural chemicals; weather; climate; watering; plant stress; cultural practices; and disease. For example, the Examiner has objected to Applicant’s description of the claimed apple tree as being of medium size and vigor, asserting that more specific information is required, i.e., “height and spread for the observed tree”

and “amount of growth over a specified period of time.” Final Office Action, page 3, paragraph A. A quantified measurement of the tree is meaningless in light of the above named factors, and others. Commercial fruit trees are planted on rootstocks, which greatly affect tree size and vigor. Furthermore, commercial fruit trees are pruned on an annual basis, making measurements of “tree size” meaningless. Because these trees are tested and grown under commercial orchard conditions, any measurement of an unpruned tree growing on its own root system has no comparative value. The general description provided is sufficient.

The Examiner has also requested highly detailed information regarding the buds, flowers and reproductive organs of the claimed plant. Final Office Action, page 4, paragraphs F-K. Applicant believes that this information is not reasonably necessary to describe the claimed plant. ‘CJ07’ is a commercial fruit tree, bred, observed, selected, and grown for its desirable fruit. Only general information regarding the bloom of the ‘CJ07’ tree has been provided, because little or no attention is paid by those skilled in the art of commercial horticulture to the appearance of the flowers. Certainly more information would be appropriate if this was an ornamental variety, but it is not.

The arguments above also apply to paragraphs B, C, D, E, L, M, O, P and R of the Final Office Action.

The Examiner has required that the Applicant provide additional information regarding the fruit flesh. Final Office Action, page 4, paragraph N. (“Applicant failed to describe the texture of the flesh of the observed fruit. Applicant should utilize a more appropriate term such as -fine-grained-, -smooth- or -crisp- as ‘Medium’ in [sic] insufficient in this regard. Correction is needed.”) Applicant believes that the description provided in the specification as filed is more than adequate. Specification, p. 5 (“Flesh: Medium firm, juicy and crisp; tinged light yellow RHSCC 10D). No additional information should be required regarding fruit size.

The Examiner has asserted that Applicant must provide additional information regarding the known shipping and storage characteristics of the fruit of the claimed variety in order to complete the description. Final Office Action, page 4, paragraph O. Applicant declined to provide additional information on this point, because all known information was provided in the application as filed. No additional descriptive information should be required regarding the fruit of the claimed plant.

The Examiner asserts that the request for additional botanical description is not unreasonable because the information requested can be obtained with a color chart and a measuring device. Applicant contends that the botanical information requested by the Examiner is neither necessary nor appropriate in this application, for the reasons set forth above, regardless of the ease with which the information might be gathered.

A Highly Detailed Botanical Description Does Not Aid the PTO in Examining Plant Patent Applications

The Examiner has argued that a highly detailed botanical description is necessary for the Examiner to make a comparison of the new variety to other known varieties, and to future varieties for which applications may be filed. Even if Applicant were to present an exhaustive botanical description of variable characteristics, pointing out the conditions under which the new plant was grown, the chances that those conditions would be identical to the conditions under which a future new variety would be grown are slim at best. The PTO still could not make a meaningful comparison of variable characteristics. As the Examiner has pointed out, only a side by side growing trial will serve to distinguish closely related varieties.

The Examiner expresses concern that a “vague and incomplete” written description may make it difficult for an examiner to compare the claimed plant to a plants claimed in future applications, and may result in rejections under 35 USC 102 of later filed applications. This concern is misplaced. An anticipation rejection under Section 102 must be based on a single reference that discloses each and every element of the claimed invention. Donald S. Chisum, Patents, §3.02. (“To anticipate a claim for a patent, a single prior source must contain all its essential elements.”) Chisum goes on to state:

Similarity or identity such as will negate novelty and constitute anticipation is determined by reference to the language of the claim of the patent or application. In this respect, the inquiry as to anticipation is symmetrical with the inquiry as to infringement of a patent. The classic test of anticipation provides: “That which will infringe, if later, will anticipate, if earlier.” Thus, a claim fails to meet the novelty requirement if it covers or reads on a product or process found in a single source in the prior art.

Donald S. Chisum, Patents, §3.02[1], footnotes omitted.

The statutorily prescribed scope of a plant patent claim is the specific plant claimed and its asexually propagated progeny. Thus, only the claimed plant itself can anticipate. Any other plant or description thereof cannot, as a matter of law, anticipate a plant invention. A plant patent application having a description identical to a previously issued plant patent is not properly rejected under Section 102, unless it can be shown that the claimed plant is the asexually propagated progeny of the patented plant (or vice versa).

Application of *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560 (Fed. Cir. 1995) to Written Description Requirement in Plant Patent Applications

In the case of *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, the Federal Circuit considered the question of whether a plant patent could be enforced against an infringer absent a

showing that the infringer had access to the patented variety. Imazio had accused Dania of infringing its patent for a unique heather plant, claiming that the plants being grown and sold by Dania were substantially identical to the plant described in Imazio's plant patent. The Federal Circuit ruled that, absent some showing that Dania had access to Imazio's patented plant material, no infringement could be found. *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, citing *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1390. ("The patentee must prove that the alleged infringing plant is an asexual reproduction, that is, that it is the progeny of the patented plant.")

The decision in the *Imazio* case reaffirms and clarifies the intentions of Congress with respect to the written description requirement for plant patents. There is no requirement, or even possibility, of providing an enabling written description in a plant patent application. Even the most exacting description of a first plant variety does not anticipate a second plant of identical description, absent a showing that the second plant is the asexually propagated progeny of the first.

Application of *In Re Greer*, 484 F.2d 488 (CCPA 1973) to Written Description Requirement in Plant Patent Applications

The U.S. Court of Customs and Patent Appeals considered the issue of descriptiveness in a plant patent application in the case of *In Re Greer*, 484 F.2d 488 (CCPA 1973). In his plant patent application, Applicant Greer had failed to provide information sufficient to fully distinguish his new variety of Bermuda grass over known varieties. The USDA assisted in the examination of the application, and determined that the description of the claimed grass was not adequate to determine if it differed from other named Bermuda grasses. In upholding the PTO's rejection of the application, the CCPA explained the Applicant's duty to "provide information of such a character that a meaningful comparison can be made."

Cecil Greer's patent application was rejected on appeal because he failed to distinguish his new variety from the parent and other known varieties. This is not the case in the present application. Applicant has clearly and at some length described the distinguishing features of the variety. The Examiner has not cited other varieties as anticipating the new variety, or even suggested that the new variety is indistinguishable from its parent or from any other known peach tree.

Requirement that Applicant Conform Written Description to Terms Selected By Examiner is Unreasonable

The present application has been rejected because the Applicant has declined to provide the specific botanical information requested by the Examiner. The application contains a substantial and reasonable botanical description of the claimed plant. The Examiner's request for additional information is unsupported by specific reasons as to why such detail is necessary to a reasonably complete description, other than that the descriptive categories in question have appeared in other patents. The Examiner has apparently relied upon previously issued patents to suggest the need for specific additional descriptive information. However, the Examiner did not acknowledge or respond to Applicant's argument that elements of the botanical description as filed in this application are in relative terms very similar to those used in the patent application for the parent variety, 'Sciearly.'

Applicant has reviewed a large number of issued plant patents, and notes that there is substantial variability in the amount and precision of botanical descriptions provided. See, for example, U.S. Plant Patent Nos. 10,114, 10,458, 13,753 and 11,092, . Each of these issued 'Gala'-type apple tree patents presumptively contains a "reasonably complete" botanical description, although each is unique and may provide more or less detail on a given characteristic as compared to another patent. Note, for example, the variation in the botanical descriptions included in the above

named patents, as compared with the botanical description provided for 'CJ07' as shown in Table 1
(next page):

Table 1: Comparison of Botanical Detail Provided in Various Issued Plant Patents and 'CJ07' Application

	PP 10,114	PP 10,458	PP 13,753	PP 11,092	CJ07
Tree size	Medium	Medium-small	Medium size typical of other Gala trees, semi-dwarf due to dwarfing rootstock. Height 8 - 10 ft. Width 7 - 9 ft.	Medium	Medium
Petiole size	Medium, 1 to 1.25 inches	28 mm long, thick	22 to 37 mm; average 26 mm (1.5 mm average diameter.)	Length 2.8 cm	Length 30 - 45 mm
Flower	Similar to Tenroy cv.; medium timing; medium size; white petals with pink each side; sterile; many flower clusters similar to Gala	Size: medium, larger than Gala. Color: White when open, pink before opening. Flowering period: April 22-April 29. Pollinators: Any diploid in same season	Large, 52-60 mm; pink in bud stage, white in full flower; bud color 2.5t 7/6; 5 petals, rounded apex, acuminate base, smooth margin and texture, margins touching to overlapping	Medium time of beginning of flowering, blossom about Oct. 5, full bloom October 10; medium size; flat shape; margin of petals overlapping; color of bud just before flower opens, pink, 63C	Medium blooming period, starting about 5 October for 2 weeks; medium size; margin not touching; bud colour pink RHSCC 55b fading to white as flower opens; 5 small sepals, pointed green with red tips
Reproductive organs	--	--	Stamen single row, anthers bright yellow 2.5Y 3.5/12; pistil - stigma medium length, branched at top into 5 elements; styles medium	--	Pubescent ovary
Storage & shipping	--	Keeping quality good, 3 months in common refrigerator	--	Keeping quality very good. No significant disorders after 100 days storage	Keeping quality excellent
Disease resistance & susceptibility	--	"None noted"	--	Medium susceptibility to major pests and diseases of apple	--

In the absence of an approved plant description template¹, an Applicant for a plant patent must have a reasonable amount of freedom in describing the claimed plant. As shown in Table 1, that freedom has typically been afforded Applicants in the past. Otherwise, the result is uncertainty on the part of the applicant in determining what information to observe, record, and include in a patent specification. If the Applicant does not include certain information that the Examiner later determines, based on some unknown criteria, is necessary for a reasonably complete description of the plant, the Applicant is sent back to the field to gather the information, or, as in this case, is faced with the rejection of its application. ‘CJ07’ has been described in terms very similar to those used in the patent for its parent ‘Sciearly,’ but for reasons that the Examiner has not explained, what was sufficient for ‘Sciearly’ is not sufficient for ‘CJ07.’

Due to the nature of living organisms, certain botanical features are available for observation only during limited periods during the growing cycle of a plant. In the case of permanent crop plants such as trees, shrubs and vines, some information is available only for a brief period during the year. If the timing of the Examiner’s request does not coincide with the availability of data, the applicant must suspend or continue its application in order to avoid abandonment, while it waits to obtain the necessary information when it becomes available. This uncertainty places a burden on the applicant which, in light of the above arguments regarding the scope of the plant patent claim and absence of a requirement for an enabling written description, is unreasonable.

In the present plant patent application, Applicant filed a skillfully prepared botanical description of its new apple tree. For all of the reasons expressed above, Applicant believes that no

¹ The International Union for the Protection of New Varieties of Plants (UPOV) has developed Testing Guidelines to be used to describe new plant varieties in which rights are claimed. Although the United States is a member of UPOV, the USPTO does not recognize the UPOV Testing Guidelines.

further botanical description is required, and that the Examiner's rejection under 35 U.S.C. §§112 and 162 is in error.

8. Appendix: A copy of the claim on appeal is attached as an Appendix to this brief.

Conclusion

For the reasons stated above, Applicant believes that the plant patent application for "Apple Variety Named 'CJ07'" meets the requirements of 35 USC 112, first and second paragraphs, and 35 USC 162. Accordingly, Applicant respectfully requests that the Board of Patent Appeals and Interferences overturn the Examiner's rejection in this case, and remand the application to the Examiner for allowance and issuance. Any questions or comments relating to this application may be directed to the Applicant's representative who signs below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Michelle Bos", is written over the printed name.

Michelle Bos, PTO Reg. No. 45,499

STRATTON BALLEW PLLC

213 South 12th Avenue

Yakima, WA 98902

Telephone (509) 453-1319

Facsimile (509) 453-4704

APPENDIX

Claim:

We claim a new and distinct apple tree, substantially as shown and described herein.